

REMARKS

The Final Office Action dated April 21, 1003 has been reviewed and the comments of the U.S. Patent and Trademark Office have been considered. The above amendments to the claims and the following remarks are respectfully submitted to place the application in condition for allowance. Claims 1-8, 10-19 and 42-71 are currently pending in this Application.

Objection to the Specification

The Examiner objects to the continuing data on page 1 of the specification. The Examiner states that it is not clear what parent applications are being relied upon for priority. The continuing data has been amended so as to more clearly indicate the priority applications. Withdrawal of the objection is respectfully requested.

In addition, the Examiner objects to the specification at page 2, line 7 because the new paragraph inserted at this point uses semicolons where commas should be used and is grammatically awkward. The paragraph has been amended to include commas rather than semicolons. Accordingly, Applicants respectfully request that the Examiner withdraw the objections to the specification.

Objection to the Oath/Declaration

The Examiner states that the Oath/Declaration is defective because it does not mention the parent applications being relied upon for priority as set forth in the new continuing data. Applicants traverse this objection. Applicants submit a courtesy copy of the "Declaration and Power of Attorney for Patent Application" previously filed with the PTO on February 28, 2003, which lists each parent application being relied upon. Also attached is a copy of the February

28, 2003 PTO date stamped postcard acknowledging receipt of the Declaration. Accordingly, Applicants respectfully request that the Examiner withdraw the objection and acknowledge the declaration and claim for priority.

Rejection under 35 U.S.C. § 112, First Paragraph

Claims 11, 15, 54 and 58 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner contends that the new combination claims appear to lack original support for the fixed side member having a branch stent because it is not seen how the fixed side member was originally disclosed as having a branch stent thereon (see Fig. 3).

Applicants traverse this rejection. The claims and disclosure are part of the specification as filed and fully comply with the requirements of 35 U.S.C. § 112. The Examiner is referred to the specification describing the catheter 64 as shown and described with reference to Fig. 10, for example, where catheter 64 has a catheter body and a side member that is “fixably attached” to the catheter body. See, e.g., the specification at page 7, lines 16-18, and page 12, lines 27-29. As shown and described with reference to Fig. 17, for example, catheter 64 may be modified to include balloon 112 at the distal end of the side member and a branch vessel stent 114. See, e.g., the specification at page 15, lines 11-19. As in Fig. 10, catheter 64 in Fig. 17 is shown having the catheter body and side member fixably attached and Fig. 17 includes a balloon 112 and a branch vessel stent 114. Applicants respectfully submit that the rejection of claims 11, 15, 54 and 58 under § 112, first paragraph, is improper and should be withdrawn.

Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 49 and 68 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner contends that, with regard to claim 49, the language of the claim is unclear because it seems to be based on intended use manipulative steps and thus it is not clear what structure the claim language positively requires. With regard to claim 68, the Examiner states that the phrase “the at least one location” lacks antecedent basis from claim 50.

Applicants respectfully request clarification of the statement “...the language of the claim is unclear because it seems to be based on intended use manipulative steps and thus it is not clear what structure is positively required by the claim language.” Claim 49 depends from claim 2 that recites two structures, a radiopaque marker positioned on the catheter and a radiopaque positioned on the side member. Claim 49 further defines the positioning of the radiopaque markers in two distinct positions—juxtaposed in a first configuration prior to positioning in the side branch and separated in a second configuration during positioning in the side branch. The language of claim 49 (and claim 2 from which it depends) clearly indicates the required structures.

Claim 68 has been amended to depend from claim 65 and thus provides correct antecedent basis.

Accordingly, it is respectfully submitted that amended claims 49 and 68 are in condition for allowance. Applicants respectfully request that the Examiner withdraw the rejection of claims 49 and 68.

Rejections under 35 U.S.C. § 102(e)

Claims 1, 7, 10, 13, 16-19, 42, 44-48 and 71 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Fischell et al. (U.S. patent 5,749,825). This rejection is traversed.

Independent claim 1 calls for the side member being fixedly attached to at least one location on the catheter, *yet* a distal portion of the side member is disposed **beneath** a portion of the stent and the distal portion of the side member that is disposed **beneath** is capable of being movable with respect to the catheter.

In contrast, Fischell et al. discloses a stent proximal portion (21), a balloon (23) and a side branch tube (24) mounted on the outer surface of the balloon (23) (see Fischell et al., Figure 1 and Col. 2, lines 45 through 50) and, as recognized and pointed out by the Examiner, the side member “must be fixed” to the shaft at least at the crotch point (Office Action at page 4). In Fischell the side branch tube portion disposed beneath the stent is not capable of being movable with respect to the catheter. Fischell et al. fails to disclose each and every element of claim 1. Furthermore, Fischell et al. fails to disclose or suggest the claimed invention and, even further, teaches away from the invention as claimed in claim 1. As recognized and pointed out by the Examiner, Fischell et al. “must be fixed,” as explained above.

Accordingly, it is respectfully submitted that claim 1 is in condition for allowance. At least for the reasons discussed above for claim 1, dependent claims 7, 10, 13, 16-19, 42, 44-48 and 71 are also in condition for allowance.

Rejections under 35 U.S.C. § 103(a)

Claims 2-6, 49-51, 53, 56, 59-68 and 70 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,749,825 to Fischell et al. (Fischell '825), in view of U.S. Patent No. 5,669,932, Fischell et al. (Fischell '932). This rejection is traversed.

Claim 50 calls for a catheter with a first radiopaque marker, a side member with a second radiopaque marker, and the markers are juxtaposed in a first configuration and separated in a second configuration. Separation indicates to the user, for example, that the distal end of the side member is in the branch vessel and the catheter is in the main vessel. Thus the position of the distal end of the side member can be indicated by the alignment or separation of the radiopaque markers as claimed.

In contrast, Fischell '825 discloses a radiopaque marker band 30 mounted in the inner shaft to help obtain longitudinal positioning of the stent delivery catheter system. But Fischell '825 fails to disclose or suggest a marker on the side branch tube. The Examiner relies on Fischell '932 to disclose two radiopaque marker bands located within the balloon of the catheter. But, in Fischell '932, the two markers are located in the same balloon and the markers are allegedly there to indicate the proximal and distal extremities of the stent when the balloon is expanded. (See Fischell '932, Col. 1, lines 50 through 60). There is no motivation to combine the Fischell patents. But, even if combined, the combination teaches nothing more than more markers in the same balloon. There is no disclosure or suggestion in either of the Fischell references to place markers anywhere other than inside the balloon, let alone on the side sheath. Moreover, the Fischell references relied upon by the Examiner are devoid of any disclosure or teaching of the claimed markers juxtaposed in a first configuration and separated in a second configuration.

Accordingly, it is respectfully submitted that claim 50 is in condition for allowance. At least for the reasons discussed above for claim 50, dependent claims 2-6, 49, 51, 53, 56, 59-68 and 70 are also in condition for allowance.

CONCLUSION

It is respectfully submitted that entry of this Amendment is appropriate insofar as it places the Application in condition for allowance. In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the Application and timely allowance of pending claims 1-8, 10-19 and 42-71. Applicants invite the Examiner to contact Applicants' undersigned representative if there are any issues that can be resolved via telephone conference. **EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this Application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-2228. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,



Michele Van Patten Frank

Reg. No. 37,028
PATTON BOGGS, LLP
8484 Westpark Drive, 9th Floor
McLean, Virginia 22102
Phone: (703) 744-7907
Fax: (703) 744-8001

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